

Appl. No. **09/934,549**
Amdt. dated July 27, 2007
Response to Office Action of 06/05/2007

Attorney Docket No.: TS01-285
N1085-90132

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Amendment to the Drawing:

No drawing amendments are filed herein. A Drawing Sheet showing Annotated Changes made to Figure 2 in Applicants' previous response filed 27 February 2007, is attached hereto. In particular, elements 50, 51 were added.

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Attachment: One Annotated Sheet Showing Changes

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REMARKS/ARGUMENTS

Claims 1-8 are presently pending in this application and each, including independent claims 1 and 4, has been rejected. Claims 1, 4, 5, 6 and 8 are amended herein. Applicants respectfully request re-examination, reconsideration and allowance of each of pending claims 1-8.

I. Claim Objections

In paragraph 2 of the subject Office action, claim 8 was objected to due to a typographical error. Claim 8 has been amended to now depend from method claim 4. The objection to claim 8 should therefore be withdrawn.

II. Drawings

In paragraph 4, Applicants were required to submit a marked-up copy of the replacement sheet filed on 27 February 2007, the replacement sheet to include annotations indicating the changes made to the previous version of the figure. Applicants herein file an "Annotated Sheet Showing Changes" in compliance with this requirement.

III. Claim Rejections Under 35 USC § 112

In paragraph 6 of the Office action, claims 1-8 were rejected under 35 U.S.C. § 112, second paragraph, for being indefinite due to the recitation in the claims of Cartesian coordinates. The claims have been amended and now do not recite Cartesian coordinates. The rejection of claims 1-8 under 35 U.S.C. § 112, second paragraph, should therefore be withdrawn.

IV. Claim Rejections Under 35 U.S.C. § 103

In paragraph 9 of the subject Office Action, claims 1-8 were rejected under 35 U.S.C. § 103(a) as being unpatentable over USP 6,421,113 to Armentrout in view of USP 4,999,617 to Iizuka, USP 5,787,057 to Fan, USP 6,454,512 to Weiss, USP 5,749,589 to Hopkins, Germany 3917874 to Seibert, USP 4,293,095 to Veralrud, and

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USP 5,873,585 to Engelking. Applicants respectfully submit that these claim rejections are overcome for reasons set forth below.

The rejected claim set includes independent claims 1 and 4. The rejection of independent claims 1 and 4 should be withdrawn for at least the following reasons:

- 5 (1) the references have been randomly and impermissibly combined using hindsight reconstruction gleaned from the invention itself and a prima facie case of obviousness has not been established;
- 10 (2) the primary Armentrout reference teaches away from the proposed combination with the other references; and
- (3) at least the claimed shock absorber feature is not disclosed in the cited references, taken alone or in combination.

(1) References Improperly Combined - No Motivation to Combine References

- 15 As a first matter, Applicants submit that the claim rejections under 35 U.S.C. §-103(a) are merely speculative and that the Examiner has impermissibly used hindsight reconstruction to select particular features from EIGHT different references to arrive at the inventive combination of features as claimed.

- 20 The unrelated elements from the different disclosures do not render the combination thereof obvious, as alleged by the Examiner. The Examiner impermissibly combined the references. Applicants respectfully submit that the Examiner has simply and impermissibly relied upon hindsight to arrive at the determination of obviousness. "It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teaching of the prior art so that the claimed invention is rendered
- 25 obvious. This court has previously stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to

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deprecate the claimed invention". *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992) at USPQ2d 1783-84 (quoting *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988)).

5 It is a combination of limitations that are non-obvious under the conditions of 35 U.S.C. § 103, even though some of the limitations may be separately known. Applicants submit that a holding that combination claims are invalid based merely upon finding similar elements in separate prior art patents would be contrary to statute and would defeat the congressional purpose in enacting title 35. *Smithkline Diagnostics, Inc. v. Helena Labs. Corp.*, 859 F.2d 878, 8 USPQ2d 1468 (Fed. Cir. 1988). A patented
10 invention cannot be invalidated piecemeal by finding individual features separately in the prior art. The hindsight reasoning employed in using the invention as a roadmap to find its prior art components, would discount the value of combining various existing features or principles in a new way to achieve a new result -- often the very definition of invention. Applicants respectfully submit that the Examiner has not shown some
15 suggestion or motivation, before the invention itself, to make the claimed combination, as required in *Ruiz v. AB Chance Co.*, 357 F.3d 1270, 69 USPQ2d 1686, 1690 (Fed. Cir. 2004). The Examiner has therefore not established a prima facie case of obviousness.

20 Obviousness cannot be established by combining the teaching of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so. *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 221 USPQ 929, at 933 (Fed. Cir. 1984).

25 The Examiner has not upheld the burden of identifying this motivation or suggestion in the prior art to combine the references as such, because *there is no motivation or suggestion in* the references to combine them to provide the claimed features because the references are drawn to different arts, i.e., the *Photolithography System Including a SMIF Pod and Reticle Library Cassette Designed for ESD*

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Protection of Armentrout; the Reticle Conveying Device of Iizuka; the CD-ROM Testing Apparatus of Fan; the Person-Guided Vehicle of Weiss; the Shelving Unit for Medicinal Containers of Seibert; the Cabinet for Holding Magnetic Tape Cartridges and Cassettes of Veralrud; the Self-Leveling Wafer-Lot Cart of Engelking; and the Airline Baggage Cart of Hopkins.

Applicants respectfully submit that the reason that the Examiner has not shown any suggestion to make the claimed combination is because there is no such suggestion to combine the references and, in fact, the Armentrout reference teaches away from combination as proposed by the Examiner.

10 (2) Armentrout Teaches Away From the Proposed Combination

Armentrout is directed to a SMIF (Standard Mechanical Interface) pod used as a reticle carrier. As shown in the figures in Armentrout, particularly in Figures 3, 6 and 9, the SMIF includes a handle 103 for transporting the SMIF by lifting and carrying, not by pushing the SMIF pod along a surface such as the ground.

15 Moreover, the SMIF only includes one stack of reticles 300 and the SMIF pod is dimensioned to closely surround the stacked reticles. It is known to one of ordinary skill in the semiconductor manufacturing art that reticles typically have dimensions ranging from about 150mm to 200mm – at most - and the illustrations of Armentrout reflect that which is known to one of ordinary skill in the semiconductor manufacturing art – that the
 20 lateral dimensions of the SMIF pod are not much greater than that of a reticle itself. Reticles are also known to have negligible thickness. Since the illustrated examples only show a handful (6 in Figure 9) of stacked reticles accommodated in a SMIF pod, and as known to one of ordinary skill in the art of semiconductor manufacturing, it is clear that the SMIF pod provided in Armentrout is sized to be either carried by hand or
 25 transferred using standard automated transport tracks and systems that are common in semiconductor manufacturing areas. SMIF pods are not rolled along a floor and one would not modify the SMIF pod of Armentrout by placing wheels on the SMIF pod and pushing it around as one would an airline baggage cart, as proposed by the Examiner.

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Moreover, as the acronym name implies, the SMIF includes an *interface*. In the illustrated figures, the interface is the bottom as the SMIF cooperates with O-ring 204 so that the base of the SMIF pod can be placed on and interface with the pertinent semiconductor manufacturing equipment. Base 102 of the SMIF pod is received in
5 corresponding locations on the semiconductor manufacturing equipment, and there would thus be no motivation or suggestion to modify an individual SMIF pod by disturbing the interface portion, in particular by providing wheels and shock absorbers such as provided in a reference directed to an airline baggage cart for transporting large numbers of pieces of luggage (Hopkins), or a large transport cart such as provided in
10 Weiss, which transports a number of larger items including, ironically, wafer carriers 18 (Figure 3) which are comparable in size to SMIF pods of Armentrout. The shock absorbers in both Weiss and Hopkins are provided to cushion a large piece of transport equipment as it rolls along the ground.

Applicants respectfully submit that one would not modify the hand-carried single
15 SMIF pod of Armentrout to include wheels and/or shock absorbers as taught in references directed to large transport carts that are pushed along a floor (Weiss) or even larger airline baggage carts driver along the tarmac, as proposed by the Examiner. Armentrout teaches away from such combination.

20 (3) The Claimed Shock Absorber Feature is Not Disclosed or Suggested in the References

Independent claim 1 recites:

a lower portion . . . comprising . . . a platform having a first and second surface opposite said first surface, said wheels being attached to said first surface of said platform;

25 shock absorbers, being mounted on the second surface of said platform; and

an upper portion disposed over said shock absorbers, said shock absorbers forming an interface between said platform and said upper portion.

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Independent claim 4 recites:

said lower portion further comprising a platform having a first and an opposed second surface, said wheels being attached to said first surface of said platform;

5 shock absorbers mounted on the second surface of said platform; and

said upper portion interfacing with said shock absorbers of said lower portion, said shock absorbers disposed between said platform and said upper portion.

10 It is seen that, in each of independent claims 1 and 4, there is a platform having opposed surfaces. Wheels are attached to one of the surfaces and the shock absorbers are attached to the opposite surface. The Office action concedes that the primary reference of Armentrout does not disclose shock absorbers and identifies Hopkins for providing the shock absorber feature.

15 The Office action suggests that Hopkins provides the claimed shock absorbers: "Hopkins, et al. further teaches the idea of providing shock absorbers 76 being disposed between a platform 35 and an upper portion 21, such as shown in Figure 4 . . ." subject Office action, page 4, lines 19-21. An examination of Figures 4 and 5 of Hopkins reveals that the dampening pad 76 of Hopkins is disposed on angle bracket 79. The
20 dampening pad 76 is attached to one surface of the angle bracket 79, but wheels are clearly not attached to the opposed surface of the angle bracket 79. Wheels 30 are laterally spaced from the angle bracket 79 and are attached to a completely different member. As such, Hopkins does not satisfy the claimed limitation of the wheels and shock absorbers being attached to opposed surfaces of a platform or any other feature.

25 The Hopkins reference therefore does not make up for the acknowledged deficiencies of Armentrout and the six other references recited above, and therefore independent claims 1 and 4 are distinguished from Armentrout in view of the secondary references.

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In Summary, Hopkins does not provide the claimed shock absorbers and the references of Iizuka, Fan, Weiss, Hopkins, Seibert, Veralrud and Engelking do not make up for the acknowledged deficiencies of Armentrout. Further, the references have been impermissibly combined and a prima facie case of obviousness has not been
5 established. Hence, the rejection of claims 1 and 4 under these references should be withdrawn.

Dependent claims 2, 3 and 5-8 are similarly distinguished and the rejection of these claims should also be withdrawn.

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CONCLUSION

Based on the foregoing, each of pending claims 1-8 is in allowable form and the application in condition for allowance, which action is respectfully and expeditiously requested.

- 5 The Assistant Commissioner for Patents is hereby authorized to charge any fees necessary to give effect to this filing or credit any excess payment that may be associated with this communication to deposit account 04-1679.

Respectfully submitted,

10 Dated: 27 July 2007


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15 Attachment: Appendix with Annotated Sheet Showing Changes

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APPENDIX